



US025009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Shuichi HIRAYAMA

Serial No.: 10/076,956

Filed: February 19, 2002

For: BOOT LINER

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Patent Art Unit: 3728

Examiner: Anthony D. Stashick

REQUEST FOR PRE-APPEAL CONFERENCE

Assistant Commissioner of Patents
Washington, DC 20231

Sir:

In accordance with the Notice published in the July 12, 2005 Official Gazette, Applicant hereby requests a Pre-Appeal Conference. The issue at hand has a factual basis, and therefore appears to be appropriate for a Pre-Appeal Conference. The Examiner's omission of essential elements needed for a *prima facie* rejection presents a clear legal or factual deficiency in the rejections. Thus, the rejections are suitable for consideration in a Pre-Appeal Conference.

A Notice of Appeal and the appropriate fees are filed with this request. No fee is believed to be due for the proper submission of the request. However, the Commissioner is authorized to charge any fees necessary associated with an extension of time to Deposit Account No. 50-1836.

Background

Claims 1, 6-13 and 15-28 were finally rejected in the June 10, 2005 Final Office Action as being unpatentable over U.S. Patent No. 6,012,236 (Pozzobon) in view of U.S. Patent No. 3,925,916 (Garbuio), U.S. Patent No. 5,746,015 (Clement) and U.S. Patent No. 5,775,006 (Breuner).

It is noted that claim 1 was finally rejected in the June 10, 2005 Office Action although it was cancelled in the Amendment submitted December 14, 2004. Thus, claim 1

will not be discussed herein. Claims 6-13 and 15-28 are pending with claims 8, 13 and 28 being the only independent claims.

Concise Explanation of Arguments

The combination rejection of independent claims 13 and 28 does not show first and second banana-shaped pads being thicker than a thermoformable layer.

Independent claims 13 and 28 recite, *inter alia*:

A *boot liner* comprising:
a sole portion; and
an upper portion having a foot section fixedly coupled to said sole portion, an ankle section extending upwardly from said foot section and a leg section extending upwardly from said ankle section, ***said upper portion including a thermoformable layer*** located on an inner side and an outer side of said ankle section, ***a first banana-shaped pad*** located in said outer side of said ankle section, ***and a second banana-shaped pad*** located in said inner side of said ankle section...

each of said first and second banana-shaped pads being thicker than said thermoformable layer of said ankle section and extending laterally towards each other relative to said thermoformable layer of said ankle section,
said first and second banana-shaped pads being configured and arranged to support an ankle joint of a wearer of *said boot liner* at bottom and rearward sides of the ankle joint of the wearer....

In the Pozzobon, Garbuio and Clement combination rejection, Garbuio is relied on to teach first and second banana-shaped pads. However, the thickness of the pads 8 in Garbuio is not discussed or illustrated. Pozzobon and Clement do not remedy the deficiency of Garbuio. Pozzobon and Clement disclose thermoformable layers without showing a banana-shaped pad and therefore do not show a thickness in relation to a banana-shaped pad. Therefore, the limitation of the first and second banana-shaped pads being thicker than the thermoformable layer is not disclosed in the combination rejection.

The combination rejection of independent claims 8, 13 and 28 does not show an upper portion of a boot liner with first and second banana-shaped pads.

Claims 8, 13 and 28 recite, *inter alia*:

A *boot liner* comprising:
a sole portion; and
an upper portion having a foot section fixedly coupled to said sole portion, an ankle section extending upwardly from said foot section and a leg section extending upwardly from said ankle section, ***said upper portion including a thermoformable layer*** located on an inner side and an outer side of

said ankle section, *a first banana-shaped pad located in said outer side* of said ankle section, and *a second banana-shaped pad located in said inner side* of said ankle section...

said first and second banana-shaped pads being configured and arranged to support an ankle joint of a wearer of *said boot liner* at bottom and rearward sides of the ankle joint of the wearer....

As can be seen above, independent claims 8, 13 and 28 require an upper portion of a boot liner to have first and second banana-shaped pads. The Examiner asserts that Garbuio discloses first and second banana-shaped pads in an upper portion of a boot liner. Garbuio illustrates a pad 8 in Figure 1. Under the "Brief Description of the Drawing" heading in column 1 of Garbuio, Figure 1 is described as a sectional view of a *ski boot 1* lined with an insert 2. Figure 2 is described as an elevational view of the *insert 2 without the boot 1*.

Most importantly, Figure 2 does not show the banana-shaped pad 8. This is because the pad 8 is *not part of the liner 2*. Rather, the pad 8 is separate from the liner 2 and, as described at column 2, line 29, is juxtaposed with the insert 2. That is, the pad 8 and the liner 2 are side by side. The pad 8 is clearly part of the boot 1 and lies next to the insert 2.

Not only is the banana-shaped pad 8 separate from the liner 2, but it is also *exteriorly* juxtaposed with the insert 2. This is in *direct contradiction* with claims 8, 13 and 28, which require a boot liner with an upper portion having a first banana-shaped pad located *in* the outer side of the ankle section and a second banana-shaped pad located *in* the inner side of the ankle section.

The combination rejection of independent claim 13 does not show first and second banana-shaped pads located between a thermoformable layer and an inner layer disposed on an interiorly facing side of the thermoformable layer.

Since Garbuio discloses a pad 8 that is disposed in a boot 1 *exterior* to the insert 2, it is impossible for the combination to teach first and second banana-shaped pads between a thermoformable layer and an inner layer disposed on an *interiorly* facing side of the thermoformable layer. At best, the combination shows a pad juxtaposed with an *exteriorly* facing side of an insert having a thermoformable layer.

The combination rejection of independent claims 8 and 28 does not show a first strap portion overlying a part of the first banana-shaped pad and a second strap portion overlying a part of the second banana-shaped pad.

Independent claims 8 and 28 recite, *inter alia*:

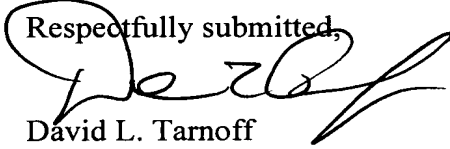
...said upper portion including a tightening device fixed thereto with a first strap portion overlying a part of said first banana-shaped pad and a second strap portion overlying a part of said second banana-shaped pad....

The Office Action cites Breuner for the teaching of first and second strap portions. Breuner discloses yokes 26 and 28, which are fixed to the *boot* 12, 18 itself not the boot liner 48. (See column 5, lines 7 and 8 of Breuner.) Furthermore, Breuner does not disclose a first or second strap portion overlying a part of a banana-shaped pad located in an *ankle section*, as claim 8 requires. Rather, Breuner discloses straps 50, 52, 56 that are incapable of overlying a banana-shaped pad in an *ankle section* since the yokes 26 and 28 cover the *ankle section*.

Conclusion

In view of the above comments, Applicant respectfully requests that the rejections be withdrawn. Applicant respectfully asserts that claims 6-13 and 15-28 are in condition for allowance.

Respectfully submitted,


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